REMARKS/ARGUMENTS

Claims 1-46 were pending in this application. In this Amendment, claims 8, 13, and 39 are canceled and the limitations therein are respectively incorporated into independent claims 1, 10, and 36. Claims 1-7, 9-12, 14-38, and 40-46 are pending and subject to examination on the merits. The amendments to independent claims 1, 10, and 36 do not raise new issues requiring further search or consideration since they were previously examined as dependent claims.

35 USC 102(b) - Drupsteen

In the Office Action, claims 1, 2, 4, 5, 6, 9-15, 17, 19, 30, 31, 34-37, 39, and 46 are rejected under 35 U.S.C. 102(b) as being anticipated by Drupsteen (U.S. Patent No. 6,073,238). This rejection is traversed.

Drupsteen discloses a method which allows commands to be loaded and activated in a smart card in a secure manner (see c. 1, l. 45-52). In FIG. 3 of Drupsteen, a card issuer (CI) has a key K1 and a trusted third party (TTP) such as an intermediary bank has another key K2. These keys K1 and K2 are also located on a smart card (SC). As shown in FIG. 2, the card issuer (CI) produces an authentication code MAC 1 using K1 and the trusted third party (TTP) produces an authentication code MAC 2 using K2. MAC 1 and MAC 2 and a command (COM) are then received by an application provider (AP) and are transferred to the smart card (SC) where MAC 1' and MAC 2' are produced using keys K1 and K2 which reside on the smart card. MAC 1 is compared with MAC 1' and MAC 2 is compared with MAC 2' to ensure security.

To provide further security, the application provider (AP) may use a third key (K3) and a set of keys K3*, which may consist of K3-1, K3-2, etc., in a smart card to selectively load commands into the card (c. 3, l. 60-67). The keys in Drupsteen are not retrieved or transported at any time. As explained at c. 5, l. 16 of Drupsteen, K3 may be a wildcard. *This is only time that Drupsteen ever mentions a wildcard.*

1. All limitations are not taught or suggested by Drupsteen

Drupsteen does not teach or suggest the inventions of independent claims 1, 10, 30, and 36. In the Office Action, the Examiner states Drupsteen discloses a method of securely loading commands in a smart card comprising a computer readable medium comprising "a data string MC1, MC2, MC3, MC4 including one or more wildcard values". As noted above, the authorization codes MAC1, MAC 2, etc. do not have any wildcard values associated with them. Rather, a key, K3, has a wildcard value associated with it (c. 5, l. 16). Thus, Drupsteen is mischaracterized in the Office Action. The rejections based on Drupsteen should be withdrawn for this reason alone.

Despite this mischaracterization, Drupsteen still fails to anticipate or obviate independent claims 1, 10, 30, and 36. Independent claim 1 recites a method including, *inter alia*, "a first data string including one or more wildcard values, "wherein the first data string is associated with a preference of the consumer." Independent claims 10, 30 and 36 recite a similar limitation. As noted above, in Drupsteen, only the key K3 has any wildcard value associated with it. Neither key K3, nor any other key in Drupsteen, is "associated with a preference of the consumer". The key K3 is used to selectively load commands into specific applications and/or files of a card (c. 3, l. 65 to c. 4, l. 5), and has nothing to do with a consumer preference. Accordingly, claims 1, 10, 30, 36, and any claims dependent therefrom are not anticipated or obvious in view of Drupsteen.

In addition, dependent claims 4, 13, 14, 37, and 39 contain additional elements not disclosed nor suggested by Drupsteen. Claim 4 teaches an additional element wherein the data string including one or more wildcard values encompasses identification codes for two or more different products. Claim 13 teaches an additional element wherein the first data string is associated with a preference of the consumer. Claim 14 teaches an additional element wherein the first data string is associated with a product preference of the consumer. Claim 37 teaches an additional element wherein the first data string encompasses a plurality of product codes. Claim 39 teaches an additional element wherein the first data string represents one or more product preferences of the consumer. These elements are not disclosed nor suggested by Drupsteen.

35 USC 103(a) - Drupsteen

In the Office Action, claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Drupsteen. This rejection is traversed.

It is submitted that claim 3 depends on novel and unobvious independent claim 1. As noted above, independent claim 1 is patentable over Drupsteen.

35 USC 103(a) - Drupsteen and Johnsen

Claims 5, 8, 16, 18, 20-29, 32, 38, and 40-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Drupsteen in view of Johnsen (U.S. Patent Number 5,250,789) (hereinafter referred to as "Johnsen"). According to the Examiner, Johnsen discloses a shopping cart, and that "advertisements and coupons provided to a customer are geared towards the customer's perceived needs or interests as indicated by the products which are being selected." This rejection is traversed.

1. **All claim limitations are not taught or suggested by Drupsteen and Johnsen**

Claims 5, 8, 16, 18, 20-29, 32, 38, and 40-44 are not obvious in view of Drupsteen and Johnsen, because all limitations are not taught or suggested by these references. To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). MPEP 2143.03. Here, obviousness has not been established, since each and every limitation of Drupsteen and Johnsen is not taught or suggested by the prior art.

a. Independent claims 1, 10, 30, and 36

Neither Drupsteen nor Johnsen teach or suggest a method including, *inter alia*, a first data string including one or more wildcard values, "wherein the first data string is associated with a preference of the consumer" as recited in independent claim 1. Independent claims 10, 30

and 36 recite a similar limitation. Applicants have already explained why Drupsteen does not teach or suggest this limitation.

Johnsen also does not teach or suggest this limitation. Johnsen discloses a shopping display system for organizing a shopping list according to the locations of products in a store and for displaying promotions in response to a product being scanned by a product scanner (abstract). The Office Action does not indicate where a "preference of the consumer" and a "wildcard" are mentioned in Johnsen, so Applicants presume that these teachings cannot be found in Johnsen. Moreover, the shopping display system of Johnsen does not store consumer preferences since its purpose is to display promotions in response to consumer selections. Accordingly, claims 1, 10, 30, 36, and any claims dependent thereon are allowable over Drupsteen and Johnsen.

2. Independent claim 20

With respect to independent claim 20, neither Drupsteen nor Johnsen teach or suggest, *inter alia*, "retrieving the first data string [including one or more wildcard values] using a card access device". As noted above, in Drupsteen, only the key K3 has any wildcard value associated with it. Neither key K3 nor any other key in Drupsteen is ever "retrieved", let alone retrieved with a card access device. The keys in Drupsteen are used to produce authentication codes to verify the transmission of data and never leave the places where they reside. For example, as shown in FIG. 3 of Drupsteen, the key K3* stays in the application provider (AP) and the keys K1 and K2 permanently reside in the smart card (SC), card issuer (CI), and trusted third party (TTP). The keys K1, K2, and K3* are not transported or retrieved by any device let alone a card access device as in independent claim 20.

B. There is no motivation to combine Drupsteen and Johnsen

There is also no motivation to combine Drupsteen and Johnsen in the manner proposed by the Examiner. Obviousness can only be established by combining or modifying the

teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). Here, the Examiner alleges that it would have been obvious to have combined Drupsteen and Johnsen, since

> [s]uch combined system would be more effective wherein each customer could be easily tracked and associated with specific products and would be more convenient by providing alternate means, such bar code symbol) to identify each customer. (sic)

As noted above, the only place that a "wildcard" is even mentioned in Drupsteen or Johnsen is at column 5, line 16 of Drupsteen where Drupsteen discusses a "key" K3 which is used to selectively load commands into a card. Contrary to the Office Action, one would not have been led to modify or use Drupsteen's key K3 so that "each customer could be easily tracked and associated with specific products ... to identify each customer" since Drupsteen's key K3 is not even remotely used for that purpose. Accordingly, there is no motivation to modify Drupsteen with the teachings of Johnsen and the combination of Drupsteen and Johnsen is improper.

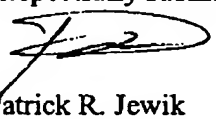
35 USC 103(a) - Drupsteen, Johnson, and Allard et al.

Claim 45 is rejected under 35 U.S.C. 103(a) as being unpatentable over Drupsteen in conjunction with Johnsen, in view of Allard et al (U.S. Patent Number 6,249,773) (hereinafter referred to as "Allard"). Dependent claim 45 depends from independent claim 36. As noted above, independent claim 36 is patentable over Drupsteen and Johnsen.

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance.

Respectfully submitted,



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